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EXAMINER

WATTS, DOUGLAS D

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3724

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Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/822,136
Filing Date: March 30, 2001
Appellant(s): KOZYRSKI ET AL.

MAILED

JUL 01 2004

GROUP 3700

Richard D Getz
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed Feb. 6, 2004.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interference*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The rejection of claims 1, 4-6, 13, 25-30 stand or fall together because appellant's brief includes a statement that this grouping of claims does exist. See 37 CFR 1.192(c)(7).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

704,352	Mathein	7-1902
5,235,748	Jahn	8-1993

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 4-6, 13, 25-30 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Mathein. Appellant sets forth the combination of a hand held cutter with a handle and a specific circular disc blade for cutting thin sheet material in claims 1, 13, 25. The blade alone is claimed in claim 28. The cutting edge angle is claimed to be 40 – 50 degrees in all claims. Claim 28 calls for a diameter to thickness ratio of less than 15. Mathein shows a disc cutter with a handle for cutting photographic sheets. Thus, it is designed to cut thin sheet material. It is acknowledged that dimensions may not be taken directly from patent drawings since they are not engineering drawings. However, “The drawings must be evaluated for what they reasonably disclose and suggest to one of ordinary skill in the art.” In re Aslanian, 200 USPQ 500 (CCPA 1979), MPEP 2125. It would appear that Mathein suggests that the disc should be rather thick and have a rather large edge angle. Since this is within or similar to the ranges claimed, 40 – 50 degrees, and a ratio of 15 or less, it would have been an obvious matter to set such ranges as being within normal parameters of conventionality dependent on the size of the blade, the material from which it is made, its rotating

speed, what material is being cut, the developed friction, and how often it is desired to replace the blade.

Claims 1, 4-6, 13, 25-30 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Jahn. Jahn shows a disc cutter for thin sheet materials with a handle. The cross section of the disc is shown in Fig 14. It would generally appear to be relatively thick with an edge angle that is rather large i. e. considerably above narrow or thin. The rationale here is as in the preceding paragraph. It would have been obvious to specify an angle for the edge to be 40-50 degrees and a diameter to thickness ratio of less than 15.

(11) Response to Argument

Appellant correctly states the inquiries of *Graham v. John Deere Co.* He then goes on to analyze the Mathein reference. Therein he states (1) that the blades must dull rapidly and also states (2) that no values are given for the angle of the cutting edge. Further he cites case law to the effect that measurements may not be taken from patent drawings and used as part of the disclosure. As to the first point the examiner fails to see the relevance thereof. However it is noted that materials and hardening techniques may have improved since Mathein's patent was granted. Therefore a new cutter of similar dimensions would presumably wear for a longer time.

Applicant's second point is that measurements may not be taken from the drawings. It is noted above that the drawings must be evaluated for what they disclose and suggest. See MPEP 2125. It is noted that Mathein at least shows a blade that is similar functionally to the claimed blade since it cuts sheet material. The examiner in

applying Mathein in a rejection based on section 103 of title 35 of the United States Code stated that the claimed ranges are prima facie obvious. It is the examiner's position at this time that the prima facie case has not been rebutted. Appellant concludes in the second declaration that the larger the angle of the cutting edge the less easily the blade cuts. The criticality of this difference is not mentioned, however, other than to state that it is noticeable to most testers. The first declaration concludes that a blade with a larger edge angle wears better than a blade with a razor type edge. It also states that it may be safer. While these would be useful parameters for an artisan to consider when designing a blade the declarations do not in themselves provide proof that an edge angle range of 40 – 50 degrees and a diameter to thickness ratio of 15 or less is critical. It thus appears that neither of the declarations addresses the criticality of the claimed ranges. Taken together they merely conclude that a blade with a large edge angle lasts longer and doesn't cut as well as a blade with a smaller edge angle. Further, the blade with a larger edge angle is safer than a razor edge blade.

In summary it is the examiner's position that the declarations fail to rebut the prima facie case since they do not address the alleged obvious features of the claimed device, namely that a range of 40 - 50 degrees would have been obvious and that a diameter to thickness ratio of less than 15 would have been obvious. It is granted that the declarations do set forth design criteria and apparently state that such criteria would be considered by one of ordinary skill in the art. The rejection has thus been maintained. Please see MPEP 2144.05 section III.

Appellant goes on to argue in the second paragraph on page 6 of the brief that "Appellant's rebuttal of the Examiner's suggestion of what would be obvious to one of ordinary skill in the art is therefor well grounded". This is a rather confusing statement since it is based on the allegation that appellant is "a person of ordinary skill in the art" which would appear to be a nonsequitur. Appellant has not stated in the declarations that the ranges alleged to be obvious were actually unobvious. Thus there was no sworn rebuttal of the Examiner's allegations of obviousness.

The remainder of the argument bridging pages 6 and 7 of the brief is purportedly based on "secondary considerations". Appellant states that he has cited specific differences between the edge angle of the reference and the claimed angle. How this allegation relates to secondary considerations is not known. Appellant then states that the declarations relate to the performance of rotary cutters with differing edge angles. This is not disputed. There appears to be no rebuttal of the prima facie obvious rejection however. The second paragraph on page 7 apparently is suggesting that the device has experienced commercial success or satisfied a long felt need. No facts to support this position have been presented.

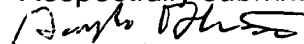
The arguments regarding the rejection based on Jahn parallel those directed to the rejection based on Mathein. Jahn shows a disc cutter with a handle that is used to cut sheet material. It is admitted that Jahn does not disclose the claimed dimensional ranges of the disc blade. It is felt, though, that the prima facie obvious rejection has not been overcome for the reasons previously stated. Specifically the declarations do not offer any evidence or expert opinion that rebuts the prima facie

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obvious allegation. In short they fail to show the criticality of the claimed ranges or of values within the claimed ranges. They set forth collections of data without mentioning how the data supports the criticality of the claimed ranges. The rejection has thus been maintained.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


Douglas D Watts

DDW

June 28, 2004

Conferees

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